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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,216	07/25/2001	Christoph Berger	ADI-074 (257/40)	5641
21323	7590	01/29/2004	EXAMINER	
TESTA, HURWITZ & THIBEAULT, LLP			STASHICK, ANTHONY D	
HIGH STREET TOWER			ART UNIT	PAPER NUMBER
125 HIGH STREET			3728	
BOSTON, MA 02110			DATE MAILED: 01/29/2004	

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Please find below and/or attached an Office communication concerning this application or proceeding.

S/M

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/915,216	BERGER ET AL.
	Examiner	Art Unit
	Anthony D Stashick	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 29 December 2003.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-27 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 July 2001 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>18</u> .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 29, 2003 has been entered.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 8-12, 17-18, and 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Moretti 5,992,052. Moretti '052 discloses all the limitations of the claims

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including the following: a sole 12 comprising an insole layer 106 defining a plurality of first openings ((see holes in layer 106 in Figure 3); a substantial portion of the plurality of first openings being interconnected (connected by portions of 106); a support layer 107 defining a plurality of second openings 111 that partially overlap the plurality of first openings (see Figure 3); an outsole layer 102 having a ground engaging surface defining at least one third opening (see Figure 1 for third opening located in outsole) extending through the outsole layer and at least partly overlaps the plurality of second openings (See Figure 3); fluidic communication exists between at least one of the first openings and the at least one third opening (air is allowed to pass through the openings to create air circulation within the shoe); the plurality of first openings (those in 106) are distributed over substantially the entire insole layer; the plurality of first openings are generally circular in shape (see Figure 3); the support layer 107 comprises a substantially compression resistant chassis; the support layer controls deformation properties of the sole (allotment for pumping of air); the support layer extends along at least one of the heel region and a ball of the foot region (see Figures 1 and 3); the plurality of second openings 111 are disposed in at least one of the toe region, arch region and a

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upwardly extending portion of the sole (See Figures 1 and 3 for location); the plurality of second openings form a grill pattern (the grill pattern is formed by the spacing of the second openings); the outsole layer extends along at least one of the heel region and the ball region (see Figure 1); the at least one third opening is disposed in at least one of a toe region and an arch region of the sole (see Figure 1); the outsole layer comprises a cushion layer (104) and a tread layer (103); a membrane is disposed between the support layer and the insole layer (see col. 4, lines 14-17).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moretti 5,992,052 as applied to claim 2 above in view of Polycarpe 6,041,518. Moretti '052 discloses all the limitations of the claims except for the first portion of the

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first openings disposed in the ball or heel region being smaller openings than the second portion of the first openings located in other regions of the sole and the size of the first portion and second portion openings. Polycarpe '518 teaches that the openings 16 located in the ball and heel regions of a shoe insole can be larger than the openings 9 in the other regions of the insole to better control the flow of air within the shoe. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the openings near the edges of the insole of Moretti '052 smaller than the holes elsewhere to allow for better control of the flow of air within the shoe. With respect to the size of the holes, it would have been well within the skill of one of ordinary skill in the art to find the different sizes of the holes needed to properly control the flow of air to the desired rate.

6. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moretti 5,992,052 as applied to claim 1 above in view of Castro 5,699,627. Moretti '052 as applied to claim 1 above discloses all the limitations of the claims except for the insole layer defining a channel for interconnecting the plurality of first openings and that channel disposed on the bottom side of the insole layer. Castro '627 teaches that an

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insole layer in located in a ventilated shoe can have channels 22 defined in the lower or bottom side of the insole layer to establish paths for air circulation on the whole side of the foot (see col. 3, lines 30-38). Therefore, it would have been obvious to place channels, such as that shown in Castro '627, between the first openings of Moretti '052 to establish paths for air circulation on the whole side of the foot whole placed within the shoe of Moretti '052.

7. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moretti 5,992,052 as applied to claim 1 above in view of Cintron 5,675,914. Moretti '052 as applied to claim 1 above discloses all the limitations of the claims except for the support layer having a support element disposed in the arch area and enclosing the arch area. Cintron '914 teaches that a support layer for a multilayered shoe can have a support element (sidewall 44) located thereon that connects the forefoot and rearfoot portions of the layer while giving needed support to the arch of the user's foot. This sidewall encompasses the wearer's foot in at least the arch area as it envelops the user's arch to support it during use. Therefore, it would have been obvious to make the support layer of Moretti '052 as applied to claim 1 above with a sidewall, as taught by Cintron

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'914, to aid in supporting the arch of the user and also allow for ventilation of the arch of the user.

8. Claims 15-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moretti 5,992,052 as applied to claim 1 above in view of Foley et al. 5,319,866. Moretti '052 as applied to claim 1 above discloses all the limitations of the claims except for the outsole comprising multiple elements including forefoot and heel elements. Foley et al. '866 teaches that the outsole of a shoe can be made of multiple elements including a forefoot element 26 and rearfoot element 28 (see Figure 6) as well as an arch element 24. This allows for better flexion of the shoe sole with respect to the natural flexion of the user's foot. Therefore, it would have been obvious to make the sole of Moretti '052 as applied to claim 1 above out of multiple elements, as taught by Foley et al. '866, to allow for better flexion of the shoe with the natural flexion of the user's foot.

9. Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moretti 5,992,052 as applied to claim 22 above in view of Burt 6,401,364. Moretti '052 as applied to claim 22 above discloses all the limitations of the claims except for the

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upper being made of mesh material located in the heel of the upper and a climate control sock that is made of two layers of mesh material and reinforced. Burt '364 teaches that the upper attached to a shoe can be made of two layers of mesh material outer layer 20 and internal layer 40 (see col. 4, lines 35-60) with a reinforcement layer 30 located in between. This arrangement allows for the user's feet to breathe while located within the shoe and prevents sweating of the user's foot. With respect to claims 25 and 26 and the sock, it appears that since the shoe of Burt '364 would include a sock in the upper (see col. 4, lines 35-60) and the invention of Burt '364 is to allow the foot to breathe while in the shoe, the idea applied to the upper of the shoe could also be applied to the sock used in the shoe for the same reasons. Therefore, it would have been obvious to make the upper and/or sock of Moretti '052 as applied to claim 22 above out of layered mesh material that is reinforced, as taught by Burt '364, to allow for the user's foot to breathe while located within the shoe and protect the user's foot from abrasions as well as cushion the foot within the shoe.

***Response to Arguments***

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is cited on form 892 enclosed herewith.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be

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reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>



Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS

January 26, 2004